

REMARKS

I. INTRODUCTION

Favorable reconsideration of this application, in light of the present amendments and the following discussion, is respectfully requested.

II. STATUS OF THE CLAIMS

By the present amendment, claims 1, 5, 8, 9, 11 and 12 are amended. That leaves claims 1-12 pending with claims 1 and 5 being independent. It is respectfully submitted that no new matter is added by this amendment.

III. SUMMARY OF THE OFFICE ACTION

In the Office Action, the drawings are objected to under 37 C.F.R. § 1.83(a) for failing to show features of claims 8, 9, 11 and 12; claims 8-11 and 12 are rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement; claims 8 and 11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention; claims 1 and 3-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Runkle* (U.S. Patent No. 3,444,753); and claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Runkle* in view of *Dykema et al.* (U.S. Patent No. 5,417,614).

IV. OBJECTION TO THE DRAWINGS

The drawings are objected to under 37 C.F.R. § 1.83(a) for failing to show the “said male member has a substantially triangular shape with flat vertexes” as recited in claims 8 and 11, and “said male member has only flat surfaces” as recited in claims 9 and 12.

In response, claims 8, 9, 11 and 12 are amended to clarify that the male member has “blunt,” instead of “flat” vertexes (claims 8 and 11) or surfaces (claims 9 and 12). Support for these amendments is found at page 5, lines 29-31 of Applicant’s disclosure.

In view of these amendments, Applicant requests reconsideration and withdrawal of the objection to the drawings.

V. REJECTIONS OF THE CLAIMS

A. Rejection of Claims 8, 9, 11 and 12 under 35 U.S.C. § 112, first paragraph

Claims 8, 9, 11 and 12 are rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Office Action suggests that limitation of “said male member has a substantially triangular shape with flat vertexes” is not supported in the specification. In response, each of claims 8, 9, 11 and 12 is amended to change “flat” to “blunt.” As mentioned above, support for that amendment can be found at page 5, lines 29-31 of Applicant’s disclosure.

Therefore, Applicant requests reconsideration and withdrawal of the rejection of claims 8, 9, 11 and 12 under 35 U.S.C. § 112, first paragraph.

B. Rejection of Claims 8 and 11 under 35 U.S.C. § 112, second paragraph

Claims 8 and 11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. More specifically, the Office Action objects to the limitation of “said male member has a substantially triangular shape with flat vertexes.” In response, claims 8 and 11 are amended to recite that “said male member has a substantially

triangular shape with blunt vertexes.” Support for that amendment can be found at page 5, lines 29-31 of Applicant’s disclosure.

Therefore, Applicant requests reconsideration and withdrawal of the rejection of claims 8 and 11 under 35 U.S.C. § 112, second paragraph.

C. Rejection of Claims 1 and 3-12 under 35 U.S.C. § 102(b) as being anticipated by Runkle

Claims 1 and 3-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Runkle*. Applicant respectfully traverses.

Independent claims 1 and 5, as amended, recites, among other elements, a female member, a male member, and at least one metal strip that is separate from the male member fitted therebetween. As discussed in Applicant’s disclosure, because the metal strip is separate from the male member, tolerances and clearance between the male and female members can be accounted for, thereby improving steering performance and reducing vibration. See page 6, lines 5-12 of Applicant’s disclosure.

Runkle fails to teach a metal strip that is separate from the male member, as recited in claim 1. *Runkle* discloses an axially movable steering column having a shaft 12 (designated as the male member in the Office Action) that is received in a bore 14 formed in a shaft 16 (designated as the fastening cage in the Office Action). A coupling mechanism 18 of *Runkle* couples the shafts and includes slidable wedge blocks 22 (designated as the metal strip in the Office Action) that are received in slots 20 (designated as the recess by the Examiner). Unlike the claimed invention, *Runkle* the wedge blocks 22 are integral with the shaft 12. That is clearly seen in Fig. 2 showing a cross-section of shaft 12 (i.e. the cross-hatching indicates that the shaft

12 and wedge blocks 22 are integral). Indeed, the wedge blocks 22 must be integral with the shaft 12 so that when the nut 34 is rotated, the load exerted by the wedge blocks 22 can be adjusted. See col. 3, lines 16-24 of *Runkle*. Moreover, one skilled in the art would not find it obvious to separate the wedge blocks 22 from the shaft because doing so would prevent the above adjustment and would worsen steering performance.

Anticipation requires that every limitation of a claim must identically appear in a prior art reference. See *Gechter v. Davidson*, 43 U.S.P.Q. 2d 1030, 1032 (Fed. Cir. 1997). It is clear that the limitation of at least one metal strip that is separate from the male member does not identically appear in *Runkle*. Absence from the prior art reference of any claimed element negates anticipation. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997).

Accordingly, because all of the claim limitations are not identically found in *Runkle*, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b).

Dependent claims 2-4 and 6-12 are also believed to be allowable over *Runkle* for the same reasons discussed above. Moreover, these claims have additional features not found in *Runkle*.

D. Rejection of Claim 2 under 35 U.S.C. § 103(a) as being anticipated by *Runkle* in view of *Dykema et al.*

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Runkle* in view of *Dykema et al.* As discussed above, claim 2 is allowable over *Runkle* for the same reasons as independent claim 1. Also, *Dykema et al.* fails to cure the deficiencies of *Runkle*. Instead, *Dykema et al.* is merely cited for the teaching of deformations.

Consequently, Applicant submits that a prima facie case of obviousness has not been established with respect to claim 2. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. § 103(a).

VI. CONCLUSION

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (001058-00031). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicant hereby petitions under 37 C.F.R. §1.36 (a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

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